

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

STEUBEN FOODS, INC.,

Plaintiff,

v.

OYSTAR GROUP, et al.,
SHIBUYA HOPPMAN CORPORATION, et al.,
GEA PROCESS ENGINEERING, INC., et al.,
JASPER PRODUCTS, LLC,
NESTLÉ USA, INC.,

Defendants.

**THIRD RULE 56(f)(3)
NOTICE**

10-CV-00780-EAW-JJM
10-CV-00781-EAW-JJM
12-CV-00904-EAW-JJM
13-CV-01118-EAW-JJM
13-CV-00892-EAW-JJM

Before the court are defendants' motions for summary judgment of patent invalidity for failure to comply with the written description requirement of 35 U.S.C. §112. [506],¹ [399] in 10-cv-781. "Compliance with the written description requirement is a question of fact but is amenable to summary judgment in cases where no reasonable fact finder could return a verdict for the nonmoving party." Streck, Inc. v. Research & Diagnostic Systems, Inc., 665 F.3d 1269, 1285 (Fed. Cir. 2012). "[U]nderlying that question is the fundamental issue whether [the inventor] actually invented the subject matter it claimed", University of Rochester v/ G.D. Searle & Co., Inc., 358 F.3d 916, 930, n. 10 (Fed. Cir. 2004), for "claims that have not been invented . . . cannot be described". Blue Calypso, LLC v. Groupon, Inc., 815 F.3d 1331, 1344 (Fed. Cir. 2016); Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1353 (Fed. Cir. 2010). Therefore, as suggested by Steuben on July 10, 2018 ([515], p. 2) and agreed to by the parties at the conference on July 11, 2018 [514], the court's sole focus at this time will be on whether Thomas Taggart invented a method for aseptically disinfecting containers using oxonia as the sterilant.

¹ Unless otherwise indicated, bracketed references are to CM/ECF docket entries in 12-cv-904.

On or before August 24, 2018 Steuben shall show cause why summary judgment of invalidity should not be entered for the reasons discussed in in my Second Rule 56(f)(3) Notice dated April 3, 2018 [497], my Decision and Order dated April 20, 2018 [501], my Decision and Order July 11, 2018 [516], and defendants' motions for summary judgment (but only to the extent that those motions relate to invention by Mr. Taggart. Other arguments raised by defendants, such as the perception of one skilled in the art, will be considered at a later date if necessary). Defendants may reply on or before September 14, 2018, and oral argument will be held before me on September 19, 2018 at 1:00 p.m. For those electing to participate in the oral argument by telephone, the court has arranged a dial-in teleconference. To access the teleconference, dial (703) 724-3100, enter access code 4100030#, and then pin 9999# sufficiently in advance of the argument.

Dated: July 11, 2018

/s/ Jeremiah J. McCarthy
JEREMIAH J. MCCARTHY
United States Magistrate Judge